

The opinion in support of the decision being entered today was **not** written  
for publication and is **not** binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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**Ex parte DANIEL I. KERPELMAN, RICHARD L. FROWEIN,  
HUBERT ANTHONY ZETTEL, JAMES F. KOHL, and  
JOHN M. HEINEN**

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Appeal No. 2005-2348  
Application No. 09/470,344

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**ON BRIEF**

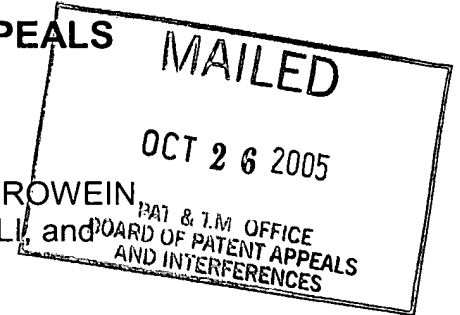
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Before HAIRSTON, KRASS, and DIXON, **Administrative Patent Judges.**  
DIXON, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-60,  
which are all of the claims pending in this application.

We REVERSE.



## **BACKGROUND**

Appellants' invention relates to a medical facility communications topology. An understanding of the invention can be derived from a reading of exemplary claims 1 and 32, which are reproduced below.

1. A medical facility data communications system, the system comprising:

an internal data communications network;

a plurality of clients coupled to the internal network and uniquely addressed on the internal network; and

a data communications control system coupled to the internal network for receiving client data from the clients, transmitting client data to a remote service provider, receiving addressed data from the remote service provider, and distributing the addressed data to the clients.

32. A communications system for a medical diagnostic facility, the system comprising:

an internal network;

a plurality of clients configured for connection to the network for transmission of client data and for receipt of addressed data, the clients including a physically mobile client; and

a data communication control system coupled to the internal network and to an external network for communicating client data and addressed data between the clients and a remote service provider, the data communications control system being configured to automatically access client data including data indicative of a location of the mobile client.

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The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Wong et al. (Wong)	6,260,021	Jul. 10, 2001
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Claims 1-60 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wong.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (mailed Oct. 4, 2004) for the examiner's reasoning in support of the rejections, and to the appellants' brief (filed May 8, 2003) and reply brief (filed Nov. 22, 2004) for appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants

[see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

### **35 U.S.C. § 103**

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**,

389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the

language of independent claim 1 which recites “a data communications control system coupled to the internal network for receiving client data from the clients, transmitting client data to a remote service provider, receiving addressed data from the remote service provider, and distributing the addressed data to the clients.”

Appellants argue that while the examiner has admitted that this limitation is not taught, the examiner's reliance upon an allegation that the element is well known in the art and further reliance upon dictionary definitions of a Domain Name System (“DNS”), Domain Name Server and a Remote Access Server (“RAS”) from the Microsoft Computer Dictionary does not cure the deficiencies in the Wong reference. (Brief at page 6 et seq. and Answer at pages 3-4 and 19-20.) The examiner further relies upon the teachings of a router and a Internet Service Provider (ISP). (Answer at pages 19-20.) The examiner further relies upon the above combination “when taken in combination with the knowledge of average skill in the art.” (Answer at pages 19.) (Emphasis deleted.)

While we agree with the examiner that knowledge and level of skill of those in the art would have been considered in the evaluation of the prior art, we do not find that the examiner has done so and provided a reasoned analysis of the prior art applied in the instant rejection. Here, we find that the examiner seems to speculate and pull random definitions and apply them directly as if within the four corners of Wong. While Wong teaches the use of Internet as a means/mode of communication, we do

not find that every aspect of the Internet based communication can necessarily be incorporated into the teachings of Wong without establishing a sufficient factual basis therefore. Here, we find no such express teachings or a reasoned line of analysis with which to meet the examiner's initial burden to establish a ***prima facie*** case of obviousness of the invention recited in independent claim 1. Additionally, we cannot agree with the examiner that the ISP or router or other intermediary in the Internet communication (as defined), clearly teaches or suggests the recited receiving and transmitting of the addressed data to and from a remote service provider. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims 2-16.

With respect to independent claim 17, as discussed above, we find no such express teachings or a reasoned line of analysis with which to meet the examiner's initial burden to establish a ***prima facie*** case of obviousness of the invention recited in independent claim 17. Additionally, we cannot agree with the examiner that the ISP or router or other intermediary in the Internet communication (as defined), clearly teaches or suggests the recited receiving and transmitting of the addressed data to and from a remote service provider. Therefore, we cannot sustain the rejection of independent claim 17 and its dependent claims 18-31.

With respect to independent claim 32, we find that the claim recites "a plurality of clients . . . , the clients including a physically mobile client; and a data communication control system coupled to the internal network and to an external network for

communicating client data and addressed data between the clients and a remote service provider, the data communications control system being configured to automatically access client data including data indicative of a location of the mobile client.” Appellants argue that the examiner’s reliance upon an e-mail address would not teach or fairly suggest providing an actual location of the mobile client. (Reply brief at page 3.) We agree with appellants and note that while the actual language does not state a physical location, we find that the reasonable interpretation of the above limitation is that the location is the physical location of the physically mobile client rather than a virtual location (on or in a network) of the mobile client which may or may not change. Therefore, we find no express teaching or a reasoned line of analysis with which to meet the examiner’s initial burden to establish a *prima facie* case of obviousness of the invention recited in independent claims 32 and 55. Therefore, we cannot sustain the rejection of independent claims 32 and 55 and their dependent claims 33-45 and 56-60.

With respect to independent claim 46, we find this claim to be quite broad, but the examiner has found that the processing and transmitting of steps (b) and (c) are not taught or suggested by Wong and the examiner relies upon the above discussed Internet based definitions. Again, we cannot agree with the examiner that the dictionary definitions teach or fairly suggest any “processing” and subsequent transmitting of client data to a remote service provider. Therefore, we find no express teaching or a



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reasoned line of analysis with which to meet the examiner's initial burden to establish a *prima facie* case of obviousness of the invention recited in independent claim 46. Therefore, we cannot sustain the rejection of independent claim 46 and its dependent claims 47-54.


## CONCLUSION

To summarize, the decision of the examiner to reject claims 1-60 under 35 U.S.C. § 103 is reversed.

**REVERSED**

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

  
ERROL A. KRASS  
Administrative Patent Judge

  
JOSEPH L. DIXON  
Administrative Patent Judge

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PATRICK S. YODER  
FLETCHER YODER & VAN SOMEREN  
P O BOX 692289  
HOUSTON , TX 77269-2289

JLD/dal